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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,273	04/09/2004	Kenneth Jacobs	00766.000101.1	9860

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FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

BRUSCA, JOHN S

ART UNIT	PAPER NUMBER
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1631

MAIL DATE	DELIVERY MODE
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03/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/821,273	Applicant(s) JACOBS ET AL.	
	Examiner John S. Brusca	Art Unit 1631	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 February 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 26 December 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 39-50.
 Claim(s) withdrawn from consideration: 51-62.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/John S. Brusca/
 Primary Examiner
 Art Unit: 1631

Continuation of 11. does NOT place the application in condition for allowance because:

The applicants have reiterated their arguments presented in the response filed 03 April 2007. To fully address the arguments, the response to the arguments in the Final Office action mailed 19 June 2007 is repeated below.

The applicants cite *In re Brana* to justify use of post filing evidence to support utility, however post filing evidence cannot be cited to provide what was absent from the specification at the time of filing, only to support that what was described at the time of filing is an enabling disclosure. The specification shows that the claimed polynucleotides encode a polypeptide that binds BMP-2 and BMP-4 at page 228, but the specification does not state whether the binding has any activation or inhibitory effect on the activity of BMP-2 or BMP-4.

The applicants have pointed to Mathura et al. for support for utility of the claimed invention. Mathura et al. merely shows BMP-2 and BMP-4 expression levels in different normal and diseased tissues, and the effect of addition of recombinant BMP-2 and BMP-4 on proliferation of cultured cells. Mathura et al. is silent on the mode of action or utility of the claimed polynucleotides that encode a polypeptide that binds BMP-2 and BMP-4.

The applicants point to Sakuta et al. for support for utility of the claimed invention. Sakuta et al. discusses a BMP-4 antagonist termed ventropin that the applicants assert is identical to the polypeptide encoded by the claimed polynucleotides. Sakuta et al. is silent regarding a utility for inhibition of BMP-4 activity. Sakuta et al. shows that treatment of embryos with ventropin results in abnormal embryo development. Sakuta et al. shows basic research on ventropin but does not show a practical application for ventropin..

In the arguments filed after final on 13 February 2008, the applicants further point to the assertion of utility at page 277, lines 13-53 in the specification. A review of page 277 of the specification shows an assertion of utility of treating peripheral nervous system disease, but the discussion is only a general allegation without specific evidence or specific discussion of the claimed subject matter of SEQ ID NO:75, or the equivalent clone dw665_4. The arguments are therefore unpersuasive.

It is further noted that a typographical error appears in the Final Office action mailed 19 June 2007. On page 5, line 10, the page range "229-228" should read "226-228."